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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/250,466 | 02/16/1999 | ILSE CHUDоба | RPE-27 | 2088 |

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EXAMINER

MORAN, MARJORIE A

ART UNIT PAPER NUMBER

1631

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/250,466

Applicant(s)

CHUDоба ET AL.

Examiner

Marjorie A. Moran

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. All objections and rejections not reiterated below are hereby withdrawn in view of the amendment filed 1/16/04.

Claim Rejections - 35 USC § 112, 2nd paragraph

Claims 47-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 recites the term "said probes" in line 4. It is unclear if the antecedent basis for this term is intended to be the "calibrating probes" of line 2 or different probes, therefore claim 47 is indefinite. Applicant has neither amended the claims nor presented arguments to overcome this rejection, therefore the rejection is maintained. This rejection may be overcome by inserting "--calibrating--" before "probes" in line 4, as such is consistent with applicant's intent.

Claim 48 recites a step of correcting positional transformations of bondings by comparison of "the position of the labels" of calibrating probes". It is unclear if applicant intends to compare positional transformation of bondings --to-- the positions of calibrating probes' labels, or actually intends to compare the positions of labels of calibrating probes to each other (as indicated by the instant claim language). It is noted that a comparison of calibrating probes' labels to each other is not supported by the instant specification or claims; however, as it is not clear what limitation applicant intends, the claim is rejected herein only for indefiniteness.

Claim Rejections - 35 USC § 102

Claims 31-44 are again rejected under 35 U.S.C. 102(e) as being anticipated by GARINI et al. (US 5,817,462, filed 4/22/1996).

Applicant's arguments filed 1/16/04 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., detection of intra-chromosomal arrangement, lack of gaps in chromosomal "painting", a number of color bands that is 2 to 4 times higher than the number of probes; i.e. use of overlapping combinatorially labeled probes which result in overlapping (new) color bands) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As GARINI teaches all of the method steps recited in the claims, the examiner maintains that GARINI anticipates the claims, as previously set forth, therefore the rejection is maintained.

Claims 31-43 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by MIRZABEKOV et al. (US 6,458,584, filed Dec. 23, 1996).

Claims 31-35 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by SHALON et al. (Genome Research (1996), volume 6 (7), pp. 639-645).

Applicant's arguments filed 1/16/04 have been fully considered but they are not persuasive. As applicant has presented arguments for these rejections simultaneously, the arguments will be addressed in the same manner. In response to the argument that the claimed method can be performed in situ and does not require isolation of the biomolecules prior to labeling, it is noted that (a) the claims do not recite an limitations with regard to in situ labeling, and (b) the claims recite open claim language (comprising) and therefore may encompass steps other than those specifically recited. As MIRZABEKOV and SHALON do teach at least all the

claimed method steps, the examiner maintains that both MIRZABEKOV and SHALON anticipate the claims, therefore the rejection is maintained.

Claim Rejections - 35 USC § 103

Claims 31-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over GARINI et al. (US 5,817,462) in view of CABIB et al. (US 5,784,162).

Applicant's arguments filed 1/16/04 have been fully considered but they are not persuasive. Applicant merely argues that CABIB Does not remedy the argued deficiencies of GARINI. In response, the examiner maintains that GARINI teaches all the limitations of claims 31-43, as set forth above, and therefore also maintains that GARINI and CABIB make obvious claims 31-46.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Friday, 7:30 am to 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marjorie A. Moran
Primary Examiner
Art Unit 1631

mam

Marjorie A. Moran
4/8/04